

MAR 10 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF PETITIONS

Patent Number: 6,505,391 B1

Patent Date: 2003 Jan 14

Applicant: Philippe Berna

Patent Title: PROCESS FOR MAKING A VERSATILE CLAMPING DEVICE DESIGNED
TO HOLD OBJECTS WITHOUT DAMAGING THEM, SUCH A DEVICE AND ITS USE.

Examiner/GAU: David Bryant/3726

#29 #99

Molières-sur-Cèze, France, 2006, March 12, Sun

RESPONSE TO THE DECISION ON THE PETITION FILED ON JULY 11, 2003
ACCOMPANIED BY AN AFFIDAVIT AND A REQUEST THAT A LATER INITIAL DATE
COULD BE SET FOR THE PERIOD FOR RESPONSE BECAUSE OF FORCE MAJEURE.

Outstanding decision of Senior Legal Advisor Kery A. Fries mailed December 20, 2005 on petition of July 11, 2003

Hon. Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Sir:

1. RESPONSE TO THE DECISION

Within the paper supporting the decision, Petitions Attorney Nancy Johnson stated page 4, line 4, that "Petitioner had the alternative of filing an RCE" and, in view of this, expressed surprise (page 4, lines 5-6) that "Petitioner articulated no reasons why he should not have been aware of this distinction". This expression of surprise questioned me because I thought that I developed in the petition something about RCE. Looking at the place in the petition (from page 7, 3 last lines to page 8, line 21) where I believed having to do so, I realized that actually when I wrote the petition I limited my argumentation to a similar approach: the transitional submission procedure according to rule 129 (a). So I searched for RCE in the MPEP chapter 200 and I discovered at paragraph 201.06 (b) that what Petitions Attorney Nancy Johnson believed as undisputed (page 3, lines 32-33, of the paper supporting the decision: "Nonetheless, it is undisputed that on August 16, 2001, patentee filed a CPA") was in fact a disputable issue.

I never filed a CPA, just continuation applications according to former rule 62, including the one, which was filed on August 16, 2001. That can be checked in the records of the file. According to paragraph 201.06 (b) in the Eighth Edition (August 2001) of the MPEP, the application filed under former rule 62 on August 16, 2001 should have been treated as an RCE, because it was filed after May 29, 2000. Indeed, it is specified in this paragraph that "A continuation or divisional application filed under former 37 CFR 1.62 on or after December 1, 1997, will be treated as an application filed under 37 CFR 1.53(d) unless the application is a utility or plant application filed on or after May 29, 2000, in which case it will be treated as a request for continued examination (RCE) under 37 CFR 1.11". The revisions 2 (May 2004) and

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3-4 (August-October 2005) of the Eighth Edition of the MPEP have even removed the restriction that the application under former rule 62 should be "filed on or after May 29, 2000," for being treated as an RCE in the paragraph 201.06 (b). Now the logical conviction, according to what any continuation application filed under former rule 62 should be treated as an RCE, has undoubtedly prevailed amid the lawyers who are responsible of the contents of the MPEP. It should be noticed in contrast that this is not the case for continuation applications under former rule 60 - see MPEP 201.06 (a) of aforementioned revisions -.

That was precisely the logic I developed in the petition I filed on November 8, 2001: I just filed continuation applications under former rule 62 in the spirit of having continuing examination, that is to say in the spirit of filing an RCE. The choice of CPA was made for me on August 16, 2001. This choice was not given to me. I discovered the existence of the CPA and of the RCE after everything was settled for me. I wondered why. I asked for justification of it in the petition of November 8, 2001. At the time, I was apparently unaware of the existence of MPEP paragraph 201.06 (b) in the Eighth Edition because I only pleaded logic. I was then also only afraid that the choice of CPA could make my application published in bad conditions, without leaving to me time enough to submit necessary corrections to the persons in charge of publishing the applications. I could not even imagine that a CPA choice could shorten my patent term after the issuance. Besides the denomination of CPA was itself confusing: continued prosecution application. An application is a close synonym of request and prosecution is a close synonym of examination, synonym that is besides largely used in the MPEP for examination (in particular in the Revision 1 of the MPEP dated August 2001, paragraph 706.07 (h) parts 7.41.02, 37 CFR 1.114 (d), and IX-XI). In other words, a CPA could as well be denominated a Request for Continued Examination (RCE). What has reinforced such a confusion in my case was the fact that the number and the date of the application remain unchanged on the few filing receipts I received: ever 08/580,493 and 12/29/1995.

A response to this petition was mailed me on 11/19/01. It informed me first that as I did not pay a new \$130.00 petition fee my petition was dismissed and secondly, citing only MPEP 706.07 (h), - that is to say without any reference to MPEP 201.06 (b) -, that it was also chosen for me already on May 15, 2000 to turn a prior application filed under former rule 62 into a CPA (of which I never have had been notified) and that now despite my new application of August 16, 2001 was filed after May 29, 2000, it was not possible to turn it into an RCE because a so-called proper CPA could not be converted to an RCE (without giving anymore a reason for). In the response I made to this decision on December 17, 2001, I said I understood the opinion of the Director of Office of Petitions since (I thought) it was in agreement with MPEP 706.07 (h). I believed to have understood. Actually, I understood nothing. I am realizing now that everything in paragraph MPEP 706.07 (h) of the Eighth Edition, Revision 1, dated August 2001, was confusing. Firstly, beyond the quotation of 37 CFR 1.114, the term "submission" was used for both a submission according to 37 CFR 1.129(a) and for an RCE according to 37 CFR 1.114 especially in part II of MPEP 706.07 (h). Secondly, as was said just above, prosecution and examination were largely and interchangeably used in this paragraph. Thirdly there was not a word upon the danger of filing a continuing application after June 8,

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1995 regarding the shortening of the patent term even not where there ought to be relevant: in the comparative table between CPA, submission under rule 129 (a) and RCE of the part XIII of MPEP 706.07 (h). In this response of December 17, 2001, I insisted upon the impossibility of submitting any correction in due time so that publication of the CPA could reflect exactly what was in the application (I filed besides on November 17, 2001 a request so that publication could be suspended until decision about the petition to get an RCE instead of an CPA) and the absence of forewarning. No final clear answer was given to this petition of getting an RCE instead of a CPA in view of this response. Perhaps this material was amalgamated to the complaint filed on November 16, 2001 on the same application to get the real filing date (08/16/01 instead of 08/23/01). The answer given on May 28, 2002 was confusing because it was granting two petitions. But as the date of 08/16/01 was acknowledged for the continuing application under former rule 62 but treated as a CPA, I gave up the question of publication. I was unaware that the CPA could shorten the patent term. I did not really appreciate the term of courtesy mentioned in "As a courtesy to applicant, instead of rejecting and returning the application as filed under a rule which no longer exists, the Office chose to treat the filing under 37 CFR 1.53 (d)." I would have preferred as a courtesy that my application would have been treated as an RCE. But I was in a hurry to have resumed the examination of my application. I thanked nevertheless Beverley Flanagan, on June 13, 2002, for her kindness and the clarity of the history she made of the case.

I just discovered preparing the present response that still before May 15, 2000, on December 15, 1998, the choice was also made for me to turn a previous continuous application under former rule 62 into a CPA.

The MPEP only incorporated the changes necessitated by the URAA in Revision 1 of its Sixth Edition September 1995, that is to say largely after the fateful date of June 8, 1995. And the information given to readers was particularly mute on the question of the duration of a granted patent. Attention of the applicants was absolutely not drawn upon the danger of filing a continuing application after June 8, 1995 regarding the shortening of the patent term and we were already in September 1995! There was no chapter 2700 about the patent term and this danger. That chapter 2700, which provided at last a clear information about the patent term appeared only for the Eight Edition in August 2001, long (more than six years!) after the fateful date of June 8, 1995. This information was published too late and in addition it was practically unnoticeable, because for finding something in the MPEP, which looks like a huge chest of drawers, with thousands of drawers, one needs to have been somewhat alerted for searching at the bottom of the good drawer or to be very lucky. It is difficult for applicants who proceed their own applications to be familiar with all chapters of MPEP. There should have been a clear alert of the applicants. At the very least, the notice that the first Examiner placed at the end of his final action of July 3, 1995 (already a bite late with respect to the fateful date) about the possibility of submissions according to rule 129 (a) should have been accompanied with a warning that any "continuation, divisional, or continuation-in-part application that was filed on or after June 8, 1995, will have a term which ends twenty years from the filing date of earliest application for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c), regardless of

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whether the application for which a benefit is claimed under 35 U.S.C. 120, 121, or 365(c) was filed prior to June 8, 1995". And at the very least, this warning should have been posted in front of the Sixth edition of the MPEP. After all, the MPEP is the fundamental document upon which is based the prosecution of the applications. I ever believed till March 2003, according to part of 35 USC 154 entitled "DETERMINATION" that my patent, which resulted from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act should be the greater of the 20-year term or 17 years from grant, because said article 154 does not say a word about continuation applications. I never imagined that a continuation application under former rule 62 was considered as a real new application. I could not also imagine a second that in the United States a law could act for the past, could breach an implicit contract, despite Article 1, Sections 9 and 10 of the US Constitution. In France, where the Constitution is by far much less democratic than the US one, no Law can be applied retroactively: "Legislation provides only for the future; it has no retrospective operation" (article 2 of the Civil Code). And any American citizen could have the benefit of it.

Anyway, could you please ask somebody of the Office of Petitions to explain me how it was possible for a patent application originally filed before June 8, 1995, according to 35 USC 154 (c) (1), to get a patent term being "the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers"? On one hand, submissions according to rule 129 (a) for getting additional final actions were limited to two and only available to such a patent application that has been pending for at least two years as of June 8, 1995. On the other hand, a patent application originally filed before June 8, 1995 has no right to the benefit of an RCE according to rule 114 - 37 CFR 1.114 (e) (2) -. Limiting the number of submissions to two is irrelevant of the will and the capability of the Examiner in charge of the prosecution of the application to accept or not the claims. When a patent is finally granted within 2 years by a second Examiner with all the claims that were refused obstinately by a first Examiner for 7 years whatever was the wording and whatever were the arguments submitted by the applicant is an evidence of the reluctance of this first Examiner to advance the prosecution (please refer to my petition of July 11, 2003, in particular pages 3-5, section 3 (A) and page 8, end of section 5) and accordingly of the insufficiency of this limitation. All the Examiners are clearly not equal regarding the capability to understand inventions and the liking to work. Clearly a gap existed between 37 CFR 1.129 (a) and 1.114 that prevented compliance with 35 USC 154 (c) (1) for all the patent applications originally filed before June 8, 1993, to which were assigned reluctant Examiners. It is to fear that the deep deficit of risk information and abundance of confusing information that has been underlined above and the exclusion of applications older than two years from the benefit of rule 129 (a) has severely aggravated this prevention from compliance.

It could be wondered whether the conjunction of this gap, this deficit of risk information and the abundance of confusing information has been set up to trap the submarine applications that were evoked in the Inventor's Digest magazine before the Uruguay Round Agreements would be reached. But could you please tell me whether in your opinion, it would be normal and fair that regular applicants eager to get a patent granted with fair claims would be penalized

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like submarine applicants? May I remind you that after careful consideration I drew the attention of the PTO authorities in a complaint on 07/29/1994 (less than two years from the entry of my application into the national phase) upon the risk that examination of my application could last eternally due to the poor technical level and the casual behavior of the first Examiner once he had sent his two first actions including a final? I was earnestly eager at getting my patent as soon as possible because I wanted to be free for devoting myself entirely to the promotion of the devices according to my invention. It is a pity that this prosecution lasted so long. But as I explained in my petition filed on July 11, 2003 - section 3 (A) and (B) -, it is far to be my fault. Besides I am the only victim of it. During all the time that lasted the prosecution, commercialization of the devices according to my invention remained almost confidential. I paid many more fees than it should be for the benefit of the PTO income. And my patent term has been reduced by 9 years. Could you please tell me whether I deserved this and if yes for what reason?

In other words, applicant has never had at his disposal clear information to choose the good way of getting an extension of the examination of his application on and after June 8, 1995 without risking to reduce drastically the patent term. If ever he would have been aware of the interest of filing submissions under rule 129 (a), instead of continuing applications under former rule 62, because of the obstinateness of the Examiner who was assigned to the examination of the application for 8 years (7+1) from the beginning to reject claims that were later allowed by his successor in 2 effective years, he would have been barred from the benefit of 35 USC 154 (c) (1), because of aforementioned gap. Of course, should a good Examiner like this successor have been assigned to the examination of the application from the beginning, the patent would have been granted with same claims by the end of 1995, without any need of filing any submission or continuing application.

So that 35 USC 154 (c) (1) could be complied with for my patent application filed on September 03, 1992 in the national phase of a prior PCT application, I beg you the benefit of the logical conviction that prevailed amid the lawyers who are responsible of the contents of the MPEP, conviction according to what any continuation application filed under former rule 62 should be treated as an RCE. I ever and only filed continuous applications under former rule 62 in the spirit of making requests for continued examination of my patent application. I beg you the benefit of the reciprocity of the non-retroactivity of the Law that my country, France, would grant to any American citizen.

Below follow an affidavit attesting above and last sentence and a request for a later initial date for the period of response to the outstanding decision.

Very respectfully submitted,

Philippe Berna

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